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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/372,416	08/11/1999	JONATHAN DORFMAN	EWG-087	1373

7590 12/12/2006

BEH Investments LLC  
1652 48th Street  
Brooklyn, NY 11204

EXAMINER
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HUYNH, THU V

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/372,416

Applicant(s)

DORFMAN, JONATHAN

Examiner

Thu V. Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is responsive to communications: amendment filed on 11/19/06 to application filed on 08/11/1999, which is continuation in part of US patent 6,285,987.
2. Claim 18 is amended
3. Claim 18 is pending in the case.
4. The objection of specification in the previous office action has been withdrawn as necessitated by the amendment.
5. All rejections in the previous office action have been withdrawn as necessitated by the amendment.

### *Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over A Angles et al., US 5,93,811, filed 08/20/96 as provided by the examiner in "notice of reference cited" mailed on 05/19/06 and in view of Davis et al., US 6,269,361 B1, filed 05/99.**

**Regarding independent claim 1, Angles teaches the steps of:**

- parsing the web page at a browser, wherein the web page includes a reference to an advertisement server representing a request for the advertisement from

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- the advertisement server (Angles, col.8, lines 34-60; col.19, lines 20-40; parsing a web page at a web browser, wherein the web page includes an advertisement request reference to advertising provider to request an advertisement from the advertisement provider);
- receiving at the advertisement server an indication of the request (Angles, col.8, lines 34-60; col.19, lines 20-40; advertisement provider advertisement request from the user);
  - selecting at the advertisement server the advertisement from among a plurality of advertisements, wherein the selection is based on the user's profile (Angles, col.8, lines 56-61); and
  - sending the advertisement to the browser, the browser superimposing the advertisement onto the web page (Angles, col.8, lines 62-67).

However, Angles does not explicitly disclose selecting an advertisement based on competitive bidding among advertisers bidding in real time.

Davis teaches advertisement is selected based on competitive bidding in real time to fulfill a request (Davis, col.5, lines 62-65; col.18, line 37 – col.19, line 7; competitive bidding among advertisers is used to decide advertisements in the search result list).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Davis's advertisers bidding into Angles' teaching, since the combination would have provided advertisement/banner/image based on user's profile and/or competitive bidding among advertisers.

### ***Response to Arguments***

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8. Applicant's arguments with respect to claim 18 have been considered but are moot in view of the new ground(s) of rejection.

Applicants point out that "claim 18 finds full support in the discloser of the prior file application", which has priority date 01/22/97. Therefore "at least the Burman and Davis references post-date the effective filing data of the present application".

However, the combination of Angles and Davis, which has priority date before 01/22/97, teaches such features as explained in the rejection above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu V. Huynh whose telephone number is (571) 272-4126. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Thu V. Huynh  
December 8, 2006